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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/500,128

06/25/2004

James Surjan

P25,624A USA

7387

29880

7590

03/25/2011

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EXAMINER

SELLERS, ROBERT E

ART UNIT

PAPER NUMBER

1765

NOTIFICATION DATE

DELIVERY MODE

03/25/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket@foxrothschild.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/500,128	<b>Applicant(s)</b> SURJAN, JAMES	
	<b>Examiner</b> ROBERT SELLERS	<b>Art Unit</b> 1765	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

This is responsive to the Request for Continued Examination (RCE) and amendment filed November 26, 2010. The three month period for suspension beginning from the filing date of the RCE has expired.

The text of the basis for nonstatutory obviousness-type double patenting and section 103(a) of Title 35, U.S. Code not included in this action can be found in the non-Final rejection mailed November 17, 2006.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 45 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention at the time the application was filed.

1. There is no support for the claimed minimum amine value of the tertiary amine in claim 45 of about 450 mg KOH/g. The specification on page 9, the fourth full paragraph in lines 10-12 disclose minimum amine values of only about 400, 500 and 600 mg KOH/g.

Claim 46 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

2. There is no basis in the original disclosure for the adhesive composition being “substantially free of thiol compounds” denoted in claim 46. According to MPEP §2173.05(i), Negative Limitations, “[a]ny claimed containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.” See *In re Johnson*, 194 USPQ 187, 196, CCPA 1977 and *Ex parte Grasselli*, 231 USPQ 393, Bd. App. 1983.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 44 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 44 denoting a minimum amine value for the tertiary amine of about 350 mg KOH/g is ultimately dependent upon independent claim 39 requiring a minimum amine value of about 400 mg KOH/g. Claim 44 does not further limit claim 39 since its minimum amine value is lower than that of the independent claim wherefrom it ultimately depends and therefore expands the range.

4. The term “substantially” used to characterize the lack of thiol compounds in claim 46 is unclear since it cannot be determined at what amount of amine the phrase “substantially free” embraces. Furthermore, there is no definition anywhere in the specification as to the amine concentration excluded by “substantially.”

Claims 20-31 and 36-48 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Surjan et al. Patent No. 6,291,555 (Surjan '555, claims 1-19), 6,403,678 (Surjan '678, claims 1, 2 and 8-10) or 6,420,458 (Surjan '458, claims 1-12 and 23-26) in view of Coleman et al. Patent No. 6,166,849 and Morgan et al. Patent No. 5,681,128.

Claims 32-35 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of Surjan et al. '555, '678 or '458 further in view of Gienau et al. Patent No. 6,645,340 and Hartman et al. Patent No. 5,962,602.

The rejections are maintained for the reasons of record set forth in the previous Office actions. The Remarks, II. Double Patenting Rejections section of the amendment on pages 5-6 indicates the consideration of filing terminal disclaimers if the claimed subject matter is otherwise allowable. The potential allowability could not be executed until such terminal disclaimers have been filed. It would be more practical if the terminal disclaimers were filed concurrently with the response to this non-Final rejection to permit time for reviewing the propriety of their formats and to eliminate any further matters hindering the processing of a possible allowance.

Claims 20-31 and 36-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Surjan et al. '555, '678 and '458 as well as Surjan et al. Patent Nos. 6,402,434 and 6,416,256 in view of Coleman et al. and Morgan et al.

Claims 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Surjan et al. patents as applied to the claims hereinabove, and further in view of Gienau et al. and Hartman et al.

The rejections are maintained for the reasons of record set forth in the previous Office actions. The argument filed November 26, 2010 has been considered but are unpersuasive.

5. The statement of common ownership must follow the prescribed format elucidated in MPEP § 706.02(I)II. Evidence to Establish Common Ownership. The statement in the Remarks section of the response filed March 22, 2010 on page 3, lines 14-16 does not affirmatively follow the format: "Instant application no. 10/500,128 and U.S. Patent Nos. 6,403,678; 6,420,458; 6,402,434 and 6,416,256 were made and owned by Illinois Too Works Inc. at the time the invention was made."

6. Surjan et al. Patent No. 6,291,555 qualifies as prior art under 35 U.S.C. 102(a)/103(a) since the patent date of September 18, 2001 antedates the effective filing date of the instant application of December 28, 2001.

Claims 20-31 and 36-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman et al., Morgan et al., Gienau et al., Hartman et al., European Patent No. 488,949; CAPLUS accession no. 1985:596803 for the Toussaint et al. article, Grieves et al. Patent No. 4,623,702 and Japanese Patent No. 2000-273354.

The rejection is maintained for the reasons of record set forth in the previous Office actions. The arguments filed November 26, 2010 have been considered but are unpersuasive.

7. Coleman et al. (cols. 7-8, Table I) shows Ancamide 1856 (Examples 5 and 10) or Ancamide 2205 (Examples 3 and 8) deemed to be suitable species of aliphatic amines according to page 10, the second paragraph of the instant specification. Although the claimed “plurality of aliphatic amines” is not exemplified, it would have been obvious to employ the Ancamide 1856 and Ancamide 2205 together.

8. According to MPEP § 2144.06, Art Recognized Equivalents for the Same Purpose, I. Combining Equivalents Known for the Same Purpose: “It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose (*In re Kerkhoven*, 205 USPQ 1069, 1072, CCPA 1980; *In re Crockett*, 126 USPQ 186, CCPA 1960 and *Ex parte Qudranti*, 25 USPQ2d 1071, Bd. Pat. App. & Inter. 1992).”

Art Unit: 1765

9. It would have been obvious to combine the Ancamide 1856 and Ancamide 2205 of Coleman et al. since each is taught to be useful for the same purpose as epoxy resin curing agents.

10. Morgan et al. (col. 12, Example 2, Table 2) shows a blend of aliphatic amines Ancamine 2014AS and Ancamine 2337XS inherently within the claimed plurality of aliphatic amines of new claim 39 having a glass transition temperature of from about 125°F to 140°F and an amine value of from about 400 mg KOH/g to about 800 mg KOH/g.

11. Gienau et al. (col. 6 Example, Component B) shows a mixture of m-xylylenediamine described on page 8, the third paragraph, line 6 of the instant specification and an aliphatic polyamine inherently within the claimed plurality of aliphatic amines of new claim 39 having a glass transition temperature of from about 125°F to 140°F and an amine value of from about 400 mg KOH/g to about 800 mg KOH/g.

12. Hartman et al. (col. 3, lines 47-52) discloses one or more amine curing agents including aliphatic amines such as isophorone diamine mentioned on page 8, the third paragraph, line 9 of the instant specification. The phrase “one or more” embraces mixtures of aliphatic amines. An amine accelerant such as the 2,4,6-tris(dimethylaminomethyl)phenol set forth on page 10, the second paragraph, lines 5-6 of the instant specification is reported in column 3, lines 53-56.



Art Unit: 1765

13. The European patent (page 2, lines 31-32) teaches a hardener component including a polyamide of a dimerized fatty acid and aliphatic amine disclosed on page 8, the third paragraph, lines 10-11 of the instant specification. A tertiary amine accelerator such as tris(dimethylaminomethyl)phenol is suitable according to page 4, line 58.

14. Grieves et al. (col. 3, lines 24-25, item (g)) espouses mixtures of isophorone diamine, diethylene triamine and triethylene tetraamine named on page 8, the third paragraph, lines 4, 5 and 9 of the instant specification. A primary accelerator such as dimethylaminomethyl phenol is included as stated in column 3, lines 41-45.

15. Toussaint et al. shows a combination of isophorone diamine, 2,2,4-trimethylhexamethylenediamine acknowledged on page 8, the third paragraph, lines 6 and 9 of the instant specification together with 2,4,6-tris(dimethylaminomethyl)phenol as a crosslinking catalyst.

16. The Japanese patent (translation, page 2, paragraph 7) sets forth aliphatic polyamines such as diethylenetriamine, triethylenetetraamine, tetraethylenepentamine or polyoxypropylene diamine or triamine listed on page 8, the third paragraph, lines 4, 5 and 11 of the instant specification. It would have been obvious to employ a mixture of such aliphatic polyamines since each is taught to be useful for the same purpose as epoxy resin curing agents. A hardening accelerator such as 2,4,6-tris(dimethylaminomethyl)phenol is added according to page 2, paragraph 8.

Art Unit: 1765

17. The itemization of the plurality of aliphatic amines within each of the references is clearly elucidated hereinabove. Hartman et al., the European patent, Grieves et al., Toussaint et al. and the Japanese patent clearly established the use of aliphatic amines with 2,4,6-tris(dimethylaminomethyl)phenol as a hardening accelerator.

18. Coleman et al., Morgan et al. and Gienau et al. do not recite the claimed tertiary amine. It would have been obvious to employ the 2,4,6-tris(dimethylaminomethyl)phenol of Hartman et al., the European patent, Grieves et al., Toussaint et al. and the Japanese patent in the epoxy resin-aliphatic polyamine hardener compositions of Coleman et al., Morgan et al. and Gienau et al. in order to increase the cure rate. The motivation is based on the specific teachings of the references and not any hindsight reconstruction.

19. The combinations of aliphatic amine mixtures of the references including species particularly named on page 8 in the third paragraph of the instant specification inherently exhibit a glass transition temperature and amine value within the parameters defined in new claims 39, 42 and 43.

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Monday to Friday, 9:30 to 6:00

/Robert Sellers/  
Primary Examiner  
Art Unit 1765

rs  
3/21/2011